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JOAN PENNINGTON 535 NORTH MICHIGAN AVENUE UNIT 1804 CHICAGO, IL 60611			SINGH, RACHNA	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/292,444

Filing Date: April 15, 1999

Appellant(s): BATES ET AL.

Joan Pennington
For Appellant

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/26/05 appealing from the Office action
mailed 07/05/05.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,781,914 STORK et al. 07-1998

Microsoft Word Tutorial, "Microsoft Word Basic Features", Available at:
<http://baycongroup.com/wlesson0.htm>, Microsoft Word 1997.

Advanced Microsoft Word, "Footnotes and Endnotes", Available at:
<http://www.utexas.edu/cc/training/handouts/wordadv/>, 01/224/01, Copyright 1996,
Computation Center, The University of Texas at Austin.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 6, 10, 12-14, and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Stork et al., US Patent 5,781,914, 7/1998.

In reference to claims 1 and 17, Stork discloses a method in which an electronic document can be converted into a hardcopy document from a hypertext document while encoding hypertext link information (compare to “***computer-implemented method for identifying hypertext links in document printouts***”). See column 1, lines 5-10. The hypertext document is scanned to identify links (compare to “***scanning a document to be printed and identifying local hypertext links within the document***”). See column 9, lines 9-10. “Local hypertext links” are links that are located within the

document. Stork teaches that the encoded information includes location information such as the line number in order to identify the area of the hyperlink (compare to “**computing and storing a page location of each identified local hypertext link within the document**”). See column 5, lines 1-30, figure 1, and column 4, lines 38 et seq. Stork teaches that once the location of the encoded link information has been identified, the machine-readable information is recognized and decoded to determine the hypertext link information contained therein. Once the encoded information has been decoded and specific active regions in the plain text portion of the document identified, the hyperlink information is associated with the active words and or objects and processing is performed to create the hypertext document such that the selection of the marked word causes that **portion of the document** (links to another portion within the document are local hypertext links) or **other documents** (links to other documents are external hypertext links) to be retrieved based on the resource locator within the link information. See figure 1, and column 4, lines 38 et seq., column 5, lines 60-67 and column 6, lines 1-34. Stork further discloses displaying the hypertext document image on a screen. The hardcopy document that results contains hypertext link information in machine-readable format to enable conversion back into a hypertext document format. Thus, the link information will be available to the user to enable a reversal back into hypertext information. See column 8, lines 30-37. Compare to “**sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a**

corresponding uniform resource locator (URL) for each external hypertext link".

Stork does not employ the term, "anchor tag"; however, he does disclose identifying each printable object within a hypertext anchor tag when he teaches decoding the hypertext link information and retrieving the document based on the resource locator within the link information because the endpoints of hyperlinks must be identified in order to describe the hyperlinks; furthermore, an anchor is no more than a description of the endpoints of a hyperlink thus in describing hyperlinks, the endpoints (i.e. anchor) must be identified. See columns 5-8.

In reference to claim 2 and 6, Stork discloses that a hypertext link can be linked to information within the document or an external document. See Stork, column 4, lines 39-41. Stork teaches encoding the links with the actual path information. See column 5, lines 25-30. The path information is encoded with the link while rendering the printable objects.

In reference to claim 3, Stork discloses identifying the location of the hypertext link by line number. See column 5, lines 5-25. Stork discloses printing out a hardcopy identifying the page number for an internal link to identify the location of the related hyperlink region with a line number.

Claim 10 is rejected under the same rationale used to reject claim 1 above.

In reference to claim 12, Stork discloses identifying the location of the hypertext link by line number. See column 5, lines 5-25.

Claim 13 is rejected under the same rationale used to reject claim 1 above.

Claim 14 is rejected under the same rationale used to reject claim 3 above.

Claim 16 is rejected under the same rationale used to reject claim 3 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stork et al., US Patent 5,781,914, 7/1998 in view of Microsoft Word Tutorial, "Microsoft Word Basic Features". <http://baycongroup.com/wlesson0.htm>, Microsoft Word 1997.

In reference to claims 4, 5, and 8, it was notoriously well known in the art at the time the invention was made to modify text to be displayed in various formats such as superscript form or bold form. See Microsoft Word Tutorial, pages 3-4. It would have been obvious to one of ordinary skill in the art of document display to modify the printable text of Stork to be represented in bold or superscript form to provide some distinction between the bolded or superscripted text and normal text.

Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stork et al., US Patent 5,781,914, 7/1998 in view of Advanced Microsoft Word, "Footnotes and Endnotes" <http://www.utexas.edu/cc/training/handouts/wordadv/>

In reference to claim 9, it was notoriously well known in the art at the time the invention was made to display text in footnote form. See Advanced Microsoft Word, pages 3-7. It would have been obvious to one of ordinary skill in the art of document display to modify the printable text of Stork to be represented in footnote form in order to provide comments on or provide a reference to a designated part of the text.

In reference to claim 7, Stork discloses encoding information consisting of actual path information (URL). See column 5, lines 25-30. It would have been obvious to one of ordinary skill in the art at the time the invention was made to display the URL for an external link since it was common to identify the path in a hyperlink. Moreover, it was notoriously well-known in the art at the time the invention was made to display text in footnote form. See Advanced Microsoft Word, pages 3-7. It would have been obvious to one of ordinary skill in the art of document display to modify the printable text of Stork to be represented in footnote form in order to provide comments on or provide a reference to a designated part of the text.

(10) Response to Argument

With respect to claims 1-2, 6, 7, 9, and 14, Appellant argues Stork does not provide any remote suggestion of identifying hypertext links in the document printouts. See page 13 of Brief. Examiner respectfully disagrees as Stork teaches encoding and storing hypertext link information in a hardcopy document (see abstract and figure 1 which depict hyperlink information). Encoding and storing hypertext link information is “identifying hypertext links in document printouts” because it allows the hyperlink to be “identified”. Identifying is simply a means for recognizing links which is depicted in

figure 1. It is noted that Appellant merely states that Stork does not teach certain limitations without specifically addressing Examiner's reliance on particular portions of the reference and stating why Appellant believes the portion does not teach what Examiner purports them to teach. Simply stating "the cited reference provides no suggestion for a particular feature" does not illustrate why the portions of the reference does not teach the feature.

Appellant further argues Stork does not anticipate "identifying each printable object within a hypertext anchor tag". Examiner respectfully disagrees. Stork teaches checking the encoded link information and decoding it which entails identifying a printable object within a hypertext anchor tag. The hyperlink is then associated with active words or objects and the portion of the document (local link) or other documents (external links) are retrieved based on the URL with the link information. Stork teaches that once the location of the encoded link information has been identified, the machine-readable information is recognized and decoded to determine the hypertext link information contained therein. Once the encoded information has been decoded and specific active regions in the plain text portion of the document identified, the hyperlink information is associated with the active words and or objects and processing is performed to create the hypertext document such that the selection of the marked word causes that **portion of the document** (links to another portion within the document are local hypertext links) or **other documents** (links to other documents are external hypertext links) to be retrieved based on the resource locator within the link information. See figure 1, and column 4, lines 38 et seq., column 5, lines 60-67 and column 6, lines

1-34. Stork further discloses displaying the hypertext document image on a screen. The hardcopy document that results contains hypertext link information in machine-readable format to enable conversion back into a hypertext document format. Thus, the link information will be available to the user to enable a reversal back into hypertext information. See column 8, lines 30-37. Compare to "***sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link***".

Stork does not employ the term, "anchor tag"; however, he does disclose identifying each printable object within a hypertext anchor tag when he teaches decoding the hypertext link information and retrieving the document based on the resource locator within the link information because the endpoints of hyperlinks must be identified in order to describe the hyperlinks; furthermore, an anchor is no more than a description of the endpoints of a hyperlink thus in describing hyperlinks, the endpoints (i.e. anchor) must be identified. See columns 5-8.

Again, it is noted that Appellant merely states that Stork does not teach certain limitations without specifically addressing Examiner's reliance on particular portions of the reference and stating why Appellant believes the portion does not teach what Examiner purports them to teach. Simply stating "the cited reference provides no suggestion for a particular feature" does not illustrate why the portions of the reference does not teach the feature.

In reference to claims 3, 12, and 16, Appellant argues Stork does not teach “local” or “external” hypertext links. Examiner respectfully disagrees. See column 4, lines 38 et seq where Stork teaches once the encoded information has been decoded and specific active regions in the plain text portion of the document identified, the hyperlink information is associated with the active words and or objects and processing is performed to create the hypertext document such that the selection of the marked word causes that **portion of the document** (links to another portion within the document are **local** hypertext links) or **other documents** (links to other documents are **external** hypertext links) to be retrieved based on the resource locator within the link information. See figure 1, and column 4, lines 38 et seq., column 5, lines 60-67 and column 6, lines 1-34. Stork clearly teaches “local” and “external” hypertext links as defined by the Appellant (i.e. local refers to a section of the document and external to another URL).

In reference to claims 10, 13, and 17 Applicant argues lack of novelty. Examiner disagrees in view of rejections above. Appellant merely states that Stork does not teach certain limitations without specifically addressing Examiner’s reliance on particular portions of the reference and stating why Appellant believes the portion does not teach what Examiner purports them to teach. Simply stating “the cited reference provides no suggestion for a particular feature” does not illustrate why the portions of the reference does not teach the feature.

In reference to claims 4, 5, and 8, Appellant argues the subject matter is not taught by Stork or Microsoft Word Publication without specifically addressing

Examiner's reliance on particular portions of the reference and stating why Appellant believes the portion does not teach what Examiner purports them to teach. As stated in the rejections above, it was notoriously well known in the art at the time the invention was made to modify text to be displayed in various formats such as superscript form or bold form. See Microsoft Word Tutorial, pages 3-4. It would have been obvious to one of ordinary skill in the art of document display to modify the printable text of Stork to be represented in bold or superscript form to provide some distinction between the bolded or superscripted text and normal text.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



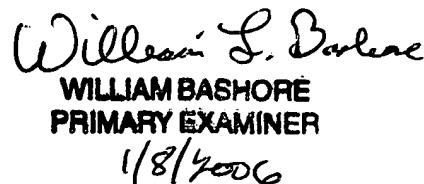
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